

ESTTA Tracking number: **ESTTA638380**Filing date: **11/12/2014**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	D.M.C. SRL		
Entity	Societa a responsibilita limitata	Citizenship	Italy
Address	Via dei Bar, 14 San Vendemiano (TV), I-31020 ITALY		

Attorney information	Nicholas D. Wells Kirtan McConkie 60 E. South Temple, Suite 1800 Salt Lake City, UT 84111 UNITED STATES nwells@kmclaw.com Phone:801-328-3600
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Applicant Information

Application No	86090072	Publication date	10/14/2014
Opposition Filing Date	11/12/2014	Opposition Period Ends	11/13/2014
Applicant	Manuelita S.A. Km. 7 VÃ-a Palmira - El Cerrito Palmira, COLOMBIA		

Goods/Services Affected by Opposition

Class 031. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Agricultural, horticultural, forestry products and grains, namely, agricultural seeds, agricultural grains for planting, bulbs and seeds for horticultural purposes, and bulbs and seeds for agricultural purposes; fruits; raw vegetables and fresh vegetables

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3207846	Application Date	10/03/2005
Registration Date	02/13/2007	Foreign Priority Date	NONE
Word Mark	MANUEL CAFFÃ#		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 1975/00/00 First Use In Commerce: 2004/03/00 Coffee

U.S. Registration No.	4381811	Application Date	07/20/2012
Registration Date	08/13/2013	Foreign Priority Date	02/20/2012
Word Mark	GHIOTTOLO DOLCE FARCITO CON CREMA AL CAFFÈ# MANUEL CAFFÈ#		
Design Mark			
Description of Mark	<p>The mark consists of the following: a black shaded vertical rectangle, with a vertical gold line on the far left and right of the rectangle. Centrally and horizontally disposed, dominates the stylized word "Ghiottolo" in the color gold. Below is the wording "Dolce" appearing above "farcito con crema al caffè" all in the color gold in which the word "Dolce" is larger than the words "farcito con crema al caffè" below. Further below is a design consisting of a red oval with white outlining. Centered within the oval design is a coffee plant with cup, both in the color</p>		

	white. Under the design is the stylized wording "MANUEL CAFFÃ#" where the letters "M" and "L" of the word "MANUEL" appear larger than the other letters. The word "MANUEL" appears altogether in the color white and the underlying word "CAFFÃ#" appears smaller and in the color red.
Goods/Services	Class 030. First use: First Use: 0 First Use In Commerce: 0 Cake as "panettone" with coffee and dark chocolate

Related Proceedings	91218984
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Attachments	78725628#TMSN.png(bytes) 79122890#TMSN.png(bytes) MANUELITA Class 31-TTAB Opposition.pdf(13945 bytes) MANUEL CAFFE - TSDR.pdf(119951 bytes) GHIOTTOLO MANUEL CAFFE - TSDR.pdf(167955 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Nicholas Wells/
Name	Nicholas D. Wells
Date	11/12/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Mark: MANUELITA (and Design)

Serial No.: 86090072

Published: October 14, 2014

D.M.C. SRL

Opposer,

v.

Manuelita S.A.

Applicant

Opposition No. _____

NOTICE OF OPPOSITION

In the matter of trademark application Serial No. 86090072 for the trademark MANUELITA (and Design) for “Agricultural, horticultural, forestry products and grains, namely, agricultural seeds, agricultural grains for planting, bulbs and seeds for horticultural purposes, and bulbs and seeds for agricultural purposes; fruits; raw vegetables and fresh vegetables” in International Class 31 filed October 12, 2013 and published in the Official Gazette on October 14, 2014.

Opposer D.M.C. SRL ("DMC"), a Societa' a Responsibilita' Limitata, equivalent to a limited liability company, organized under the laws of Italy and having a place of business at Via dei Bar, 14, I-31020 San Vendemiano (TV), ITALY, believes it will be damaged by registration of the mark in the above identified application and hereby opposes the same.

The grounds for the opposition are as follows:

1. DMC is the owner of U.S. Trademark Registration No. 3207846 for the mark
MANUEL CAFFÉ (Stylized)(CAFFÉ disclaimed) for “Coffee” in Class 30,
filed on October 3, 2005 and registered on February 13, 2007.
2. DMC has used the MANUAL CAFFÉ mark in commerce on coffee continuously
in the United States since at least as early as 2004.
3. DMC is the owner of U.S. Trademark Registration No. 4381811 for the mark
GHIOTTOLO DOLCE FARCITO CON CREMA AL CAFFÈ MANUEL
CAFFÈ (and Design) for “Cake as ‘panettone’ with coffee and dark
chocolate” in Class 30. The 3207846 and 4381811 registrations are referred
to herein collectively as the “MANUEL CAFFÈ marks.” Attached hereto are
copies of the TSDR records for each of the MANUEL CAFFÈ marks.
4. Opposer's cited registrations are valid, subsisting and enforceable.
5. DMC has expended significant resources in the design, manufacture and
promotion of products sold under its MANUEL CAFFÉ marks. The marks
have become well known as identifiers of coffee and other high-quality food
products.
6. Applicant's above identified mark MANUELITA (and Design) is likely, when
used on or in connection with Applicant's goods, to cause confusion, or to
cause mistake, or to deceive due to its being confusingly similar to Opposer's
MANUEL CAFFÉ marks and its use in connection with goods identical to or
related to the goods sold by Opposer under its MANUEL CAFFÉ marks, and
on goods which travel in the same channels of trade.

7. Opposer has priority of use in commerce and priority of registration of its
MANUEL CAFFÉ marks.
8. Applicant's mark consists of the term MANUELITA as its sole literal term and as
the most prominent feature of Applicant's mark.
9. The word MANUELITA found in Applicant's mark is used in the Spanish
language as a name or as a nickname.
10. The word MANUEL found in Opposer's marks is, among other possible
meanings, used as a name.
11. The word MANUELITA within Applicant's mark is a diminutive form of the
name MANUEL.
12. Because the only literal term within Applicant's mark is a form of the same name
that is the most prominent and only non-disclaimed term in Opposer's
MANUEL CAFFÉ mark, the wording MANUELITA conveys no additional
distinctive commercial impression to distinguish it from Opposer's MANUEL
CAFFÉ mark.
13. The goods sold by Applicant are identical or related to the goods sold by Opposer
under its MANUEL CAFFÉ marks.
14. Applicant's mark is not registrable under Section 2(d) of the Lanham Act in view
of Opposer's prior, continuous, ongoing and current use of its marks in
commerce.
15. As a result of Opposer's use and promotion of Opposer's MANUEL CAFFÉ
marks for the goods identified above, Opposer's marks have acquired
significant goodwill and have become famous prior to Applicant's first use of

its mark and the filing date of its application. Opposer's marks are famous marks within the meaning of Section 43(c) of the Lanham Act. Registration of the confusingly similar mark by Applicant will lessen the capacity of Opposer's marks to identify and distinguish the goods of Opposer, and is thereby likely to cause dilution of Opposer's marks.

WHEREFORE, Opposer believes that it will be damaged by registration of said mark and prays that this opposition be sustained.

Dated: Salt Lake City, Utah
November 12, 2014

KIRTON MCCONKIE, PC

By: /Nicholas D. Wells/

Nicholas D. Wells
1800 World Trade Center
60 E. South Temple
Salt Lake City, Utah 84111
(801) 328-3600

Attorney for Opposer
D.M.C. SRL

CERTIFICATE OF SERVICE

I hereby certify that on the 12 day of November, 2014, I served a copy of **Opposer's Notice of Opposition** on the attorney for the Applicant, as designated below, by placing said copy in the United States Mail, first class, postage prepaid, addressed as follows:

Robert B. Burlingame
Pillsbury Winthrop Shaw Pittman LLP
PO Box 2824
San Francisco, CA 94126-2824

By: _____

KIRTON MCCONKIE, PC
1800 World Trade Center
60 E. South Temple
Salt Lake City, Utah 84111

System Maintenance

USPTO will perform maintenance affecting several systems beginning at 12:01 a.m. and ending at 3 a.m., Saturday, November 15 EST.

The following systems may be unavailable during the maintenance period:

- Electronic Patent Assignment System 1.9 (EPAS)
- Assignments On the Web 2.5 (AOTW)

Assignment data will be unavailable in the following systems during the maintenance period:

- Trademark Status Document Retrieval (TSDR)
- Private Patent Application Information Retrieval (Private PAIR)

STATUS**DOCUMENTS**[Back to Search](#)[Print](#)

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Mark: MANUEL CAFFÉ



MANUEL
Caffé

US Serial Number: 78725628

Application Filing Date: Oct. 03, 2005

US Registration Number: 3207846

Registration Date: Feb. 13, 2007

Register: Principal

Mark Type: Trademark

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: May 14, 2012

Publication Date: Nov. 28, 2006

Mark Information

Mark Literal Elements: MANUEL CAFFÉ

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Color(s) Claimed: Color is not claimed as a feature of the mark.

Disclaimer: "CAFFE"

Translation: The foreign wording in the mark translates into English as CAFE.

Design Search Code(s): 01.15.05 - Vapor; Steam; Smoke

05.07.03 - Coffee beans

05.13.25 - Bales of hay or straw; Hay in bales; Other plants including bales of hay or straw; Straw

09.05.05 - Sombreros, cowboy hats (10 gallon hats), other broad-brimmed hats

11.03.03 - Coffee cups

26.03.17 - Ovals within ovals; Concentric ovals and ovals within ovals; Concentric ovals; Ovals, c

26.03.21 - Ovals that are completely or partially shaded

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Coffee

International Class(es): 030 - Primary Class

U.S Class(es): 046

Class Status: ACTIVE

Basis: 1(a)

First Use: 1975

Use in Commerce: Mar. 2004

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44D: No

Filed 44E: No

Currently 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: D.M.C. SRL

Owner Address: Via dei Bar, 14
San Vendemiano (TV) 31020
ITALY

Legal Entity Type: CORPORATION

**State or Country Where
Organized:** ITALY

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Nicholas D. Wells

Docket Number: 4832.08

Attorney Primary Email nwells@wellsiplaw.com
Address:

Attorney Email Authorized: Yes

Correspondent

Correspondent Nicholas D. Wells

Name/Address: Wells IP Law
299 S. Main St., Suite 1300
Salt Lake City, UTAH 84111
UNITED STATES

Phone: 801-444-7143

Fax: 203-295-373

Correspondent e-mail: nwells@wellsiplaw.com

Correspondent e-mail Yes

Authorized:

Domestic Representative

Domestic Representative Name: John S. Egbert and Jeremy Craft

Phone: 713-224-808

Fax: 713-223-4873

Domestic Representative e-mail: mail@egbertlawoffices.com

Domestic Representative e-mail Yes
mail Authorized:

Prosecution History

Date	Description	Proceeding Number
May 14, 2012	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
May 14, 2012	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	75461
May 11, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	75461
Apr. 27, 2012	TEAS SECTION 8 & 15 RECEIVED	
Feb. 13, 2007	REGISTERED-PRINCIPAL REGISTER	
Nov. 28, 2006	PUBLISHED FOR OPPOSITION	
Nov. 08, 2006	NOTICE OF PUBLICATION	
Oct. 06, 2006	LAW OFFICE PUBLICATION REVIEW COMPLETED	78287
Oct. 02, 2006	ASSIGNED TO LIE	78287
Sep. 27, 2006	APPROVED FOR PUB - PRINCIPAL REGISTER	
Sep. 06, 2006	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Sep. 04, 2006	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Sep. 04, 2006	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Apr. 05, 2006	NON-FINAL ACTION E-MAILED	6325
Apr. 05, 2006	NON-FINAL ACTION WRITTEN	77986
Apr. 05, 2006	ASSIGNED TO EXAMINER	77986
Oct. 07, 2005	NEW APPLICATION ENTERED IN TRAM	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMO LAW OFFICE 110

Date in Location: May 14, 2012

Assignment Abstract Of Title Information - Click to Load

Proceedings - Click to Load

System Maintenance

USPTO will perform maintenance affecting several systems beginning at 12:01 a.m. and ending at 3 a.m., Saturday, November 15 EST.

The following systems may be unavailable during the maintenance period:

- Electronic Patent Assignment System 1.9 (EPAS)
- Assignments On the Web 2.5 (AOTW)

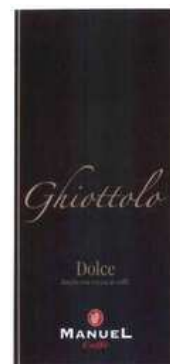
Assignment data will be unavailable in the following systems during the maintenance period:

- Trademark Status Document Retrieval (TSDR)
- Private Patent Application Information Retrieval (Private PAIR)

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Mark: GHIOTTOLO DOLCE FARCITO CON CREMA AL CAFFÈ MANUEL CAFFÈ



US Serial Number: 79122890

Application Filing Date: Jul. 20, 2012

US Registration Number: 4381811

Registration Date: Aug. 13, 2013

Register: Principal

Mark Type: Trademark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Aug. 13, 2013

Publication Date: May 28, 2013

Mark Information

Mark Literal Elements: GHIOTTOLO DOLCE FARCITO CON CREMA AL CAFFÈ MANUEL CAFFÈ

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the following: a black shaded vertical rectangle, with a vertical gold line on the left side. Centrally and horizontally disposed, dominates the stylized word "Ghiottolo" in the color gold. Below it, the word "Dolce" is written in a smaller, simpler gold font. Further down is a design consisting of a red oval with white outlining, containing a white design. At the bottom, the words "MANUEL CAFFÈ" are written in a stylized gold font, with "MANUEL" being larger and more prominent than "CAFFÈ".

Color Drawing: Yes

Color(s) Claimed: The color(s) black, gold, red, and white is/are claimed as a feature of the mark.

Disclaimer: "DOLCE FARCITO CON CREMA AL CAFFÈ" AND "CAFFÈ"

Translation: The English translation of the foreign word(s) in the mark is: "Ghiottolo Sweet filled with coffee cre

Design Search Code(s): 05.13.25 - Bales of hay or straw; Hay in bales; Other plants including bales of hay or straw; Straw
11.03.03 - Coffee cups
26.03.21 - Ovals that are completely or partially shaded
26.11.21 - Rectangles that are completely or partially shaded

Related Properties Information

International Registration [1142106](#)

Number:

International Registration Jul. 20, 2012

Date:

Claimed Ownership of US [3207846](#)

Registrations:

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Cake as "panettone" with coffee and dark chocolate

International Class(es): 030 - Primary Class

U.S Class(es): 046

Class Status: ACTIVE

Basis: 66(a)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44D: No

Filed 44E: No

Currently 44E: No

Filed 66A: Yes

Currently 66A: Yes

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: D.M.C. srl

Owner Address: Via dei Bar, 14
I-31020 SAN VENDEMIANO (TV)
ITALY

Legal Entity Type: Limited company

**State or Country Where
Organized:** ITALY

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Nicholas D. Wells

Docket Number: 4832.18

Attorney Primary Email nwells@wellsiplaw.com

Attorney Email Authorized: No

Address:

Correspondent

Correspondent Nicholas D. Wells

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UNITED STATES

Phone: 8014447143

Fax: 2032953730

Correspondent e-mail: nwells@wellsiplaw.com

**Correspondent e-mail
Authorized:** Yes

Domestic Representative

**Domestic Representative
Name:** Nicholas D. Wells

Phone: 8014447143

Fax: 2032953730

**Domestic Representative e-
mail:** nwells@wellsiplaw.com

**Domestic Representative e-
mail Authorized:** Yes

Prosecution History

Date	Description	Proceeding Number
Mar. 13, 2014	FINAL DECISION TRANSACTION PROCESSED BY IB	
Feb. 24, 2014	FINAL DISPOSITION NOTICE SENT TO IB	
Feb. 24, 2014	FINAL DISPOSITION PROCESSED	68359
Nov. 13, 2013	FINAL DISPOSITION NOTICE CREATED, TO BE SENT TO IB	
Aug. 13, 2013	REGISTERED-PRINCIPAL REGISTER	
May 30, 2013	ASSIGNED TO EXAMINER	78326
May 28, 2013	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
May 28, 2013	PUBLISHED FOR OPPOSITION	
May 08, 2013	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	

Apr. 23, 2013	LAW OFFICE PUBLICATION REVIEW COMPLETED	68552
Apr. 23, 2013	ASSIGNED TO LIE	68552
Apr. 05, 2013	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 05, 2013	EXAMINER'S AMENDMENT ENTERED	88888
Apr. 05, 2013	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Apr. 05, 2013	EXAMINERS AMENDMENT E-MAILED	6328
Apr. 05, 2013	EXAMINERS AMENDMENT -WRITTEN	88570
Mar. 27, 2013	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Mar. 27, 2013	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Mar. 27, 2013	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 13, 2013	ATTORNEY REVOKED AND/OR APPOINTED	
Mar. 13, 2013	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Feb. 08, 2013	REFUSAL PROCESSED BY IB	
Jan. 16, 2013	NON-FINAL ACTION MAILED - REFUSAL SENT TO IB	
Jan. 16, 2013	REFUSAL PROCESSED BY MPU	68359
Jan. 15, 2013	NON-FINAL ACTION (IB REFUSAL) PREPARED FOR REVIEW	
Jan. 15, 2013	APPLICATION FILING RECEIPT MAILED	
Jan. 14, 2013	NON-FINAL ACTION WRITTEN	88570
Jan. 09, 2013	ASSIGNED TO EXAMINER	88570
Jan. 09, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 03, 2013	SN ASSIGNED FOR SECT 66A APPL FROM IB	

International Registration Information (Section 66a)

International Registration Number: 1142106	International Registration Date: Jul. 20, 2012
Priority Claimed Flag: Yes	Date of Section 67 Priority Claim: Feb. 20, 2011
Intl. Registration Status: REQUEST FOR EXTENSION OF PROTECTION PROCESSED	Date of International Registration Status: Jan. 03, 2011
Notification of Designation Date: Jan. 03, 2013	Date of Automatic Protection: Jul. 03, 2014
International Registration Renewal Date: Jul. 20, 2022	
First Refusal Flag: Yes	

TM Staff and Location Information

TM Staff Information - None
File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Aug. 13, 2013

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